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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1928.

CONCRETE MIXING & CONVEYING COMPANY (a Corporation),
Petitioner,

vs.

R. C. STORRIE & COMPANY (a Partnership),
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT

AND

BRIEF IN SUPPORT THEREOF

AND

APPENDIX CONTAINING OPINIONS AND CERTAIN DECREES OF THE COURTS OF THE SECOND CIRCUIT WITH WHICH THE NINTH CIRCUIT IS IN CONFLICT.

LYNN A. WILLIAMS,
CLIFFORD C. BRADBURY,
ALBERT G. McCALEB,
Counsel for Petitioner.

STEPHEN J. COX.
Of Counsel.

Eastman Bros., Inc., Law Printers, 542 S. Dearborn St., Chicago.

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Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

To the Honorable, The Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Concrete Mixing & Conveying Company, respectfully prays for a writ of certiorari to review the judgment of the Circuit Court of Appeals for the Ninth Circuit in the above-entitled cause.

This case involves McMichael patent No. 1,127,660, granted February 9, 1915, for an invention pertaining to the pneumatic transportation and placement of concrete.

The Circuit Court of Appeals for the Ninth Circuit has held the McMichael patent invalid, notwithstanding and

in conflict with two prior decisions[1] by the Circuit Court of Appeals for the Second Circuit holding the same patent to be valid. This petition is filed for the purpose of having your Honors determine the conflict.

The Circuit Court of Appeals for the Second Circuit, **twice** considering the McMichael patent as to certain claims, including Nos. 2, 17, 34 and 35, has found that it covers a new, useful and patentable invention. The Circuit Court of Appeals for the Ninth Circuit has held that the McMichael patent does not disclose patentable subject-matter and has invalidated *these same claims.* As a result of this conflict, a large number of users of pneumatic concrete conveying and placing apparatus, and several manufacturers, in different parts of the United States, are unable to determine whether the McMichael patent is valid or invalid, and can be relieved of their dilemma only by an authoritative decision of this court. In the Second Circuit the McMachiel patent is valid, and your petitioner is there entitled to relief against infringement, whereas in the Ninth Circuit the patent has been held to be invalid, and there your petitioner can have no relief. In the other judicial circuits of the United States the validity of the McMichael patent is open and undetermined.

Your Honors have very recently been petitioned to review one of the Second Circuit decisions sustaining the McMichael patent. (See Powers-Kennedy et al., petitioners, versus Concrete Mixing and Conveying Co., No. 501, October Term, 1928.)

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1 *Concrete Mixing & Conveying Company* v. *Ulen Contracting Corporation et al.*, 12 Fed. (2) 929-931 (Circuit Judges Rogers, Hough and Mack), page 45 of the "Appendix" hereto.

Concrete Mixing & Conveying Company v. *Powers-Kennedy Contracting Corporation et al.*, 27 Fed. (2) 668 (Circuit Judges Manton, Learned Hand and Swan), page 58 of the "Appendix" hereto.

QUESTIONS PRESENTED.

The salient questions presented are:

1. Was the Circuit Court of Appeals for the Second Circuit right when, in the suits of your petitioner versus (1) Ulen Contracting Corporation *et al.*, and (2) Powers-Kennedy Contracting Corporation *et al.*, it found the McMichael patent[1] valid; **or**

Was the Circuit Court of Appeals for the Ninth Circuit right when, in the present case. it held the McMichael patent to be invalid?

2. Was the Circuit Court of Appeals for the Second Circuit right in rejecting the Smith patent No. 122,498 of 1872 as a reference against the patent in suit, and in regarding the peculiar combination of static and velocity air pressure means, including the nozzle "which injects air into the concrete at its entrance into the discharge outlet" as distinguishing the McMichael invention from all prior devices not including such a combination and such a nozzle; **or**

Was the Circuit Court of Appeals for the Ninth Circuit right in finding the McMichael patent anticipated by,

(*a*) The Smith patent—*which admittedly discloses no such combination and no nozzle of any kind.*

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[1] Claims 2, 17, 34 and 35 of the patent were involved in each of the Courts of Appeals cases, being twice found valid by the Second Circuit Court of Appeals and being held invalid by the Ninth Circuit Court of Appeals. In addition claims 4, 6, 21, 22 and 28 were involved in the Second Circuit cases, and claims 1, 18, 24 and 29 in the Ninth Circuit case. *All claims before the Second Circuit Court of Appeals were held valid, and all claims before the Ninth Circuit Court of Appeals were held invalid.* The conflict between the two Courts of Appeals is fundamental, and is entirely independent of the fact that each of the Courts of Appeals had before it a few claims of the patent which did not happen to be before the other court—due chiefly, of course, to minor differences in the defendants' structures charged to infringe.

(*b*) The alleged 1905 experiment of Thomas Leake—*which admittedly had no such combination and no nozzle of any kind,* and was supported only by a single uncorroborated and unsubstantiated deposition.

(*c*) The British patents to Duckham Nos. 4,400 of 1875 and 15,348 of 1885—disclosing machines which for *many* reasons are structurally incapable of handling concrete, and which patents, while making passing reference to certain *unillustrated* air and water agitator nozzles for stirring mud, do not describe the *location* of any kind of a nozzle in the *position* required by the McMichael patent and which years of practical experience with McMichael's machine have demonstrated is essential to the success of a pneumatic placer of concrete?

3. Was the Circuit Court of Appeals for the Ninth Circuit right when it regarded your Honors' decision in the case of *Concrete Appliances Co.* v. *Gomery,* 269 U. S. 177, as affording a basis upon which to hold the McMichael patent invalid; **or**

Was the Circuit Court of Appeals for the Second Circuit right when (in the Powers-Kennedy case) it distinguished the facts and principles in these suits involving the McMichael patent from the facts and legal principles involved in the Gomery case?

4. Was the Circuit Court of Appeals for the Ninth Circuit right in holding that the alleged prior invention and public use of McMichael's invention by one Thomas Leake was established by the verbal testimony of one witness, given more than twenty years after the alleged event and uncorroborated by any other witness, or by any contemporary device, drawing, photograph or other visible or tangible evidence; **or**

Was the Circuit Court of Appeals for the Second Circuit right when (in the Powers-Kennedy case) it applied the established rule of the Supreme Court, as set forth in *Deering* v. *Winona Harvester Works,* 155 U. S. 286, 300, and many other cases, that an alleged prior invention or public use to defeat an issued patent must be **"proven by evidence so cogent as to leave no reasonable doubt in the mind of the court"?**

5. Was the Circuit Court of Appeals for the Ninth Circuit justified in attaching importance to the alleged 1905 experiment of Thomas Leake, notwithstanding Leake's testimony that the experiment was **discarded and abandoned** immediately after it was made; **or**

Was the Circuit Court of Appeals for the Second Circuit right when (with reference to the alleged prior public use testified to by Artingstall et al. in the Powers-Kennedy case) it said:

> **"Such casual and abandoned uses do not contribute to the stock of knowledge which makes up the art. If we may invalidate a patent upon such prior uses so proved, no patent would be safe"?**

6. Was the Circuit Court of Appeals for the Ninth Circuit justified in accepting as competent evidence, relative to the alleged prior invention and use by Thomas Leake, certain statements appearing in a Patent Office preliminary statement (ex parte affidavit) made by Leake more than a year after McMichael's filing date, and certain statements made more than a year after McMichael's filing date, in Leake's patent application, by Leake's *attorney* (not called as a witness) **or**

Is such evidence inadmissible because unfair and incompetent (as your petitioner contends), being the kind of unfair and incompetent evidence which was strongly condemned by the Circuit Court of Appeals for the Second Circuit in *General Electric Co.* v. *P. R. Mallory & Company,* 298 Fed. 579, 586?

7. Was Judge Bourquin (and inferentially the Ninth Circuit Court of Appeals) right in finding that defendants' machines do not infringe the McMichael patent; **or**

Was the Second Circuit Court of Appeals (and Judge A. N. Hand) right in finding the McMichael patent infringed by machines which are substantially the same as the machines used by the defendants in this case?

BRIEF STATEMENT OF THE PRESENT CASE.

This suit was instituted in the United States District Court for the Western District of Washington. It came on for trial before his Honor Judge Bourquin, District Judge, **after** the McMichael patent had been sustained by both the District Court for the Southern District of New York and the Circuit Court of Appeals for the Second Circuit in the suit of your petitioner versus Ulen Contracting Corporation *et al.*, and after the District Court for the Southern District of New York had sustained the McMichael patent a second time in the suit of your petitioner versus Powers-Kennedy Contracting Corporation *et al.*

His Honor Judge Bourquin, in an opinion filed November 12, 1927 (R., Vol. II, pp. 610-622), found invalid the claims of the McMichael patent which were in suit. A final decree pursuant to said opinion was entered November 26, 1927 (R., Vol. II, pp. 622-623). Your petitioner appealed from such decree to the Circuit Court of Appeals for the Ninth Circuit, the cause being argued in said Court of Appeals on May 31, 1928. Following the presentation of this case to the Circuit Court of Appeals for the Ninth Circuit, but before the filing of an opinion by said Circuit Court of Appeals for the Ninth Circuit, the Circuit Court of Appeals for the Second Circuit handed down its opinion sustaining the McMichael patent a sec-

ond time in the suit of your petitioner versus Powers-Kennedy Contracting Corporation *et al.*

On August 20, 1928, the Circuit Court of Appeals for the Ninth Circuit filed an opinion (R., Vol. II, p. 666) affirming the decree of the District Court in this cause.

On September 11, 1928, your petitioner filed a petition for a rehearing in the Circuit Court of Appeals for the Ninth Circuit. Said petition for rehearing was denied on October 1, 1928 (R., Vol. II, p. 680).

The Circuit Court of Appeals for the Ninth Circuit not only held the McMichael patent to be invalid but, in arriving at such conclusion, has conflicted with the Circuit Court of Appeals for the Second Circuit in its appraisal of what is in fact the essence of the McMichael invention, in its interpretation, and the significance by it attached to the prior art structures involved, and in its application of legal principles to the facts presented.

The Smith patent of 1872, which is the first patent cited against McMichael by the Ninth Circuit Court of Appeals, was carefully considered and found not an anticipation of McMichael by the Circuit Court of Appeals for the Second Circuit in the suit of your petitioner versus Powers-Kennedy Contracting Corporation *et al.*

The other prior art (actual and alleged) which was considered by the Circuit Court of Appeals for the Ninth Circuit in its opinion is not in any sense different in *kind* from the prior art which was before the Circuit Court of Appeals for the Second Circuit in the suits of your petitioner versus Ulen Contracting Corporation *et al.*, and Powers-Kennedy Contracting Corporation *et al.*

THE PROCEEDINGS IN THE SECOND CIRCUIT CASES.[1]

Concrete Mixing & Conveying Company v. Ulen Contracting Corporation et al.

On May 9, 1923, your petitioner filed its bill of complaint in the United States District Court for the Southern District of New York, charging Ulen Contracting Corporation with infringement of the McMichael patent aforesaid. The defendant in its answer set up the various defenses usual in patent cases—among others a defense based upon the file-wrapper of the application for the patent in suit. On motion of the defendant said last mentioned defense was segregated and tried separately before his Honor Learned Hand, then District Judge, who, on October 13, 1923, filed an opinion overruling such defense. Said opinion appears in the record herein (Exhibit Book, p. 13) and is reproduced in the following "Appendix" as "Exhibit A."

Subsequently Shandaken Tunnel Corporation was made a defendant in said suit and filed its answer in due course.

On August 20, 1925, after a full trial on the merits, his Honor Augustus N. Hand, District Judge, filed an opinion finding the McMichael patent valid and infringed as to all of the claims involved in the suit. A decree pursuant to said opinion was duly entered on August 20, 1925. The opinion of his Honor Judge Augustus N. Hand appears in the record herein (Exhibit Book, p. 18) and is reproduced in the "Appendix" hereto as "Exhibit B." The decree entered pursuant to said opinion is set forth in full in the hereinafter mentioned order of affirmance by the Circuit Court of Appeals for the Second Circuit.

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1 The opinions and decrees in the Second Circuit cases are all reproduced in the "Appendix" to the brief accompanying this petition.

The defendants, Ulen Contracting Corporation *et al.*, prosecuted an appeal from said decree of August 20, 1925, to the Circuit Court of Appeals for the Second Circuit. On May 3, 1926, said Court of Appeals, after consideration of the briefs and arguments of counsel, affirmed said decree *per curiam* (12 Fed. (2) 931). The order of affirmance by the Court of Appeals for the Second Circuit appears in the record herein (Exhibit Book, p. 25) and is reproduced in the following "Appendix" as "Exhibit C."

Concrete Mixing & Conveying Company v. Powers-Kennedy Contracting Corporation et al.

On or about November 28, 1924, your petitioner filed its bill of complaint in the United States District Court for the Southern District of New York, charging Powers-Kennedy Contracting Corporation and Anthony G. Fleck with infringement of the McMichael patent aforesaid. In due course the cause came on for trial before the Honorable Augustus N. Hand, District Judge, who, on November 8, 1926, after a full trial on the merits, found the McMichael patent valid and infringed. His opinion appears in the record herein (Exhibit Book, p. 30) and is reproduced in the following "Appendix" as "Exhibit D." An interlocutory decree pursuant to said opinion was entered in said cause on November 11, 1926, a copy of said interlocutory decree being certified to your Honors and the same being reproduced in the following "Appendix" as "Exhibit E." On March 19, 1927, the Honorable John C. Knox, District Judge, entered a final decree in said cause, pursuant to said interlocutory decree and a stipulation to said final decree annexed. The stipulation dispensed with an accounting and specified that plaintiff

should recover $21,000.00 from defendants if plaintiff should prevail in the Court of Appeals. Copies of said final decree and said annexed stipulation are certified to your Honors and are reproduced in the "Appendix" hereto as "Exhibit F."

The defendants, Powers-Kennedy Contracting Corporation *et al.*, prosecuted an appeal from said final decree to the Circuit Court of Appeals for the Second Circuit. Said Circuit Court of Appeals for the Second Circuit, after consideration of the cause and the arguments and briefs of counsel, on July 17, 1928, rendered an opinion affirming said final decree of March 19, 1927 (27 Fed. (2) 668). A copy of said opinion of the Circuit Court of Appeals for the Second Circuit is certified to your Honors, and the same is reproduced in the "Appendix" hereto as "Exhibit G."

Said opinion of the Circuit Court of Appeals for the Second Circuit not only reaches a conclusion diametrically opposed to that of the Circuit Court of Appeals for the Ninth Circuit in the instant case, but conflicts with the opinion of the Circuit Court of Appeals for the Ninth Circuit upon practically every important question involved in these suits under the McMichael patent.

REASONS FOR THE ISSUANCE OF THE WRIT.

1. By reason of the conflicting decisions of the Courts of Appeals for the Second and Ninth Circuits, your petitioner stands in the anomalous position of owning a patent which is valid in the Second Circuit, where your petitioner can secure relief against infringers, but is invalid in the Ninth Circuit, where your petitioner can secure no relief.

2. The conflicting decisions of the Courts of Appeals for the Second and Ninth Circuits confront many widely

distributed users of the machines embodying the subject-matter of the McMichael patent with a serious dilemma,—they do not know whether to respect the patent or to disregard it.

3. In the absence of an authoritative decision by your Honors settling the conflict between the Courts of Appeals for the Second and Ninth Circuits, great uncertainty and confusion will arise when the McMichael patent comes before the United States Courts in circuits other than those now in conflict,—due to the inclination of some judges to follow the judgment of the Second Circuit Court of Appeals and of others to follow the Ninth Circuit Court of Appeals.

4. It is apparent that either the Circuit Court of Appeals for the Second Circuit, or the Circuit Court of Appeals for the Ninth Circuit, has incorrectly interpreted the decision of the Supreme Court in the case of *Concrete Appliances Co.* v. *Gomery,* 269 U. S. 177.

5. The decision of the Court of Appeals for the Ninth Circuit in holding the alleged prior invention and use by Thomas Leake established by the testimony of one witness, given more than twenty years after the alleged event, and unsupported by the testimony of any other witness or by any contemporary device or document, is in conflict with many decisions of the Supreme Court, including particularly the following:

Deering v. *Winona Harvester Works,* 155 U. S. 286, 300.

Eibel Process Co. v. *Minnesota & Ontario Paper Co.,* 261 U. S. 45, 60.

T. H. Symington Company v. *National Malleable Castings Company et al.,* 250 U. S. 383, 386.

6. The acceptance as evidence by the Circuit Court of Appeals for the Ninth Circuit of certain state-

ments from Leake's preliminary statement, executed long after McMichael's filing date, and of certain argumentative statements also made long after McMichael's filing date by Leake's *attorney,* not called as a witness, is contrary to the commonly recognized rules of evidence, and in direct conflict with the decision of the Circuit Court of Appeals for the Second Circuit in the case of *General Electric Co.* v. *P. R. Mallory & Co.,* 298 Fed. 579, 586.

7. The subject-matter of the McMichael patent is of great public interest and importance,—being the means now used practically to the exclusion of all others for placing concrete linings in tunnels, subways and similar engineering projects.

It is respectfully submitted that a writ of certiorari should issue.

LYNN A. WILLIAMS,
CLIFFORD C. BRADBURY,
ALBERT G. MCCALEB,
Counsel for Petitioner.

STEPHEN J. COX,
Of Counsel.

BRIEF IN SUPPORT OF PETITION.

Statement.

The pneumatic concrete placing machine of the McMichael patent is itself a matter of great public importance,—being used, practically to the exclusion of all other means, for placing concrete linings in tunnels, subways and similar engineering projects.

The machine which was held to infringe the McMichael patent in suit of your petitioner versus Ulen Contracting Corporation *et al.*, was used in constructing the Shandaken tunnel which furnishes water supply to the City of New York, whereas the machine which was held to infringe in the suit of your petitioner versus Powers-Kennedy Contracting Corporation *et al.*, was used in constructing one of the units of the New York subway system. In the instant case respondents' (defendants') machine was used in lining one of the great two-mile tunnels forming part of the Skagit River project of the City of Seattle. The McMichael machine, as made by your petitioner and its licensees, has been and is being used on numerous important enterprises.

Prior to McMichael's invention, tunnels, subways, etc., were lined with concrete by the slow and expensive method of hand shoveling and tamping concrete behind the forms. McMichael produced an apparatus which, by the application of air to concrete in a very particular way, shoots it through pipes to and behind the tunnel forms and does this *without separating the rock, sand and cement constituting the aggregates of the concrete.* This was a truly remarkable accomplishment, and one theretofore thought to be impossible by persons familiar with the characteristics of concrete.

McMichael accomplished that which seemed impossible, by a machine of extremely simple construction, characterized by the employment of pressure on the mass of concrete in a vessel in combination with a *nozzle* so located as to discharge a high velocity jet of air into the concrete at the very place where it passes (under pressure exerted upon the mass) from the tapering walls or hopper of the container into the discharge conduit. While other characteristics of McMichael's machine are necessary and are, therefore, important, this high velocity nozzle, located precisely as stated, and acting on the mass compressed in the narrow outlet, is the most important element of McMichael's machine, and is the one which, above all others, is emphasized in his specification and claims.

Due to its location and the rapidity of its functioning, it is difficult to establish just why this nozzle, when applied as taught by McMichael, will make a practical success of a machine which, if not provided with such nozzle, would be an abject failure.

In the several suits involving the McMichael patent there has been considerable discussion and difference of opinion as to the precise reasons why the velocity nozzle is such an essential and effective element in McMichael's combination and why the respondents in the instant case, like the defendants in the Second Circuit cases, were willing to subject themselves to the annoyance and expense of litigation rather than to try to place concrete pneumatically with an apparatus not embodying this essential feature.

Courts and counsel and experts may differ as to the precise reasons why the nozzle, located exactly as taught and claimed by McMichael, is such an essential element of these pneumatic concrete placing machines and is *always* used. But there is no escape from the proposition that the nozzle and its location and relation to the

mass under pressure are of the essence of McMichael's invention, and are responsible for its practical success, and that the peculiar combination including the nozzle, precisely located as defined by the claims of the McMichael patent, is the real bone of contention in this case.

His Honor Judge A. N. Hand, and the Circuit Court of Appeals for the Second Circuit, fully appreciating the importance of the nozzle and its precise location and relation to the other agencies, found no difficulty in distinguishing the McMichael invention from the prior art.

The opinions of his Honor Judge Bourquin, and the Circuit Court of Appeals for the Ninth Circuit in the instant case, reveal a failure to appreciate that the nozzle, located in a very definite place, and acting in co-operation with the pressure behind the mass, is the thing which vitalizes the McMichael concrete placer and makes it a practical and generally used machine.

This failure by the Ninth Circuit Court of Appeals to appreciate the importance of the velocity nozzle, and the significance of its very definite location and relation to the static pressure on the mass, is very largely responsible for its conflict with the Second Circuit Court of Appeals.

Certainly if the Ninth Circuit Court of Appeals had perceived the importance of the nozzle, and the fact that it must be, and always is, placed precisely where taught by McMichael and *employed to act on the compressed mass,* it would have agreed with the Second Circuit Court of Appeals in saying of the Smith patent No. 122,498 of 1872: "It cannot be regarded as an anticipation."

Similarly, if the Ninth Circuit Court of Appeals had understood the significance of the nozzle in McMichael's very definite combination, it could not have attached any importance to the alleged 1905 experiment of Leake (which admittedly was devoid of any nozzle acting on a

mass of materials or otherwise) or to the British patents to Duckham, which disclosed devices totally incapable of handling concrete and which certainly failed to illustrate or describe anything corresponding to McMichael's very definitely located high velocity nozzle.

Furthermore, if the Ninth Circuit Court of Appeals had perceived the vital significance of McMichael's definite combination of pressure operated mass and propelling nozzle, it would have concluded, as did the Second Circuit Court of Appeals, that McMichael's machine is in fact and in contemplation of law a **new machine** operating by **pressure** and not by kinetic action, and thus radically distinguished from the Callahan device which was involved in the Supreme Court case of *Concrete Appliances Company* v. *Gomery*, 269 U. S. 177.

Judge Bourquin, after finding the claims of the McMichael patent invalid, held that they were not infringed by defendants' machines because of what he, Judge Bourquin, deemed to be limitations of the McMichael patent. The Ninth Circuit Court of Appeals disposed of the case on the issue of validity and did not go into the question of infringement. It is quite clear, however, that Judge Bourquin reached the conclusion that defendants' machines did not infringe, because he differed with the Courts of the Second Circuit as to the scope to be accorded the McMichael patent. In other words, Judge Bourquin's conclusion on the issue of infringement was reached not because of any substantial structural difference between the machines of the defendants in this case and the machines held to infringe in the Ulen and Powers-Kennedy cases, but to the contrary found non-infringement because he (Judge Bourquin) was disposed to read into McMichael's claims limitations which they do not contain—limitations which Judge A. N. Hand and the Second Circuit Court of Appeals did not find in McMichael's claims.

The Outstanding Conflicts Between the Two Courts of Appeals.

I. The conflicting conclusions as to the validity of the McMichael patent.

II. The conflict as to the pertinency of the prior art.

III. The conflict as to whether this case is controlled by or distinguished from the Supreme Court decision in the case of Concrete Appliances Co. v. Gomery.

IV. The conflict as to the proof required to establish prior invention and public use.

V. The conflict as to the anticipatory effect of discarded and abandoned experiments.

VI. The conflict as to what constitutes fair and competent evidence.

VII. The conflict as to the scope of the claims of the McMichael patent.

I.

The Conflicting Conclusions As to the Validity of the McMichael Patent.

Claims 2, 17, 34 and 35 of the McMichael patent were before both Courts of Appeals, being held valid by the Second Circuit Court of Appeals and invalid by the Ninth Circuit Court of Appeals.

In addition claims 4, 6, 21, 22 and 28 of the patent were before the Second Circuit Court of Appeals and claims 1, 18, 24 and 29 were before the Ninth Circuit Court of Appeals.

All claims before the Second Circuit Court of Appeals were held valid and all claims before the Ninth Circuit Court of Appeals were held invalid—due to diametrically opposed views concerning the salient features of McMichael's machine, the prior art and the legal principles applicable to the facts presented.

II.

The Conflict As to the Pertinency of the Prior Art.

The principal reference urged against the McMichael patent in both Courts of Appeals, in the suits decided during the present year, was the Smith patent No. 122,498 of 1872 (Exhibit Book, pp. 484-489).

Of the machine shown in the Smith patent, the Second Circuit Court of Appeals, in the Powers-Kennedy case, said:

> "In any event, it was very different from McMichael's device which injects air into the concrete at its entrance into the discharge outlet. It cannot be regarded as an anticipation."

Thus it appears that the Second Circuit Court of Appeals appreciated the significance and importance of McMichael's sub-mass engaging nozzle "which injects air into the concrete *at its entrance* into the discharge outlet" and, so doing, necessarily rejected the Smith patent as a reference against McMichael.

But the Ninth Circuit Court of Appeals emphasized the Smith patent by referring to it first of all of the prior art considered by it, saying:

> "The device (Smith) included all of the features of the appellant's patent *except the nozzle for admission of air near the point of exit.*" (Italics ours.)

This last quotation, when compared with the foregoing quotation from the decision of the Second Circuit Court of Appeals, contrasts the importance which the two courts attached to McMichael's peculiar nozzle and its very definite position. The Second Circuit Court of Appeals understood its vital importance. The Ninth Circuit Court of Appeals overlooked or discounted its importance, and as a result attached unwarranted impor-

tance to prior art which the Second Circuit Court of Appeals flatly rejected.

The alleged 1905 experiment of Leake (discussed by the Ninth Circuit Court of Appeals) is in the same category as the Smith patent. It purports to be represented by a sketch made by Leake in 1927 (Defendants' Exhibit No. 127, Exhibit Book, pp. 693, 694). Admittedly it had no nozzle or anything corresponding to it.

The Duckham British patents Nos. 4,400 of 1875 and 15,348 of 1885 (Exhibit Book, pp. 597-612) are not different in kind from prior art weighed and found wanting by Judge A. N. Hand and the Second Circuit Court of Appeals in the Ulen and Powers-Kennedy cases. These British patents show devices which are entirely incapable of handling concrete. Admittedly they fail to illustrate anything corresponding to McMichael's definitely located and definitely acting nozzle. The Ninth Circuit Court of Appeals, discounting or not preceiving the importance of McMichael's nozzle, attributes importance to certain statements in Duckham's specifications relating to certain *unillustrated* air and water nozzles for stirring up mud. But it is clear, we think, that the Second Circuit Court of Appeals would have rejected the Duckham patents, if before it, just as it rejected other similar and more relevant patents because failing to disclose the essential and vitalizing elements of McMichael's machine. For example, the patent to Prindle, 179,055, June 20, 1876, which was before the Second Circuit Court of Appeals in the Ulen case, discloses another dredging apparatus which is practically identical with Duckham.

III.

The Conflict As To Whether This Case Is Controlled By or Distinguished From the Supreme Court Decision in the Case of Concrete Appliances Co. v. Gomery.

The courts of the Second and Ninth Circuits are squarely opposed with reference to the question as to whether or not the above-mentioned Supreme Court decision controls or distinguishes from the facts in these suits under the McMichael patent.

The Second Circuit Court of Appeals, clearly perceiving that McMichael's was a *new machine*, because presenting a new combination which handled concrete as *no* material had ever been handled before, found no difficulty in distinguishing the character of the McMichael patent from the character of the Callahan patent involved in the Gomery case. The courts of the Ninth Circuit disagreed.

In deciding the Powers-Kennedy case the Second Circuit Court of Appeals said:

> "The Supreme Court case, however, contains nothing, in our opinion, which casts doubt upon the correctness of the Ulen decision; in fact, it was before us when that decision was made. . . . To do this (to reconstruct the prior art to accomplish McMichael's purpose) was to make a *new machine*, and one who thought of doing it would have had a new inventive idea, that is, that of blowing concrete, which had not been done before. When that is so the physical change in the apparatus need be very little to sustain a patent. . . . The Supreme Court case does not require us to reconsider the validity of McMichael's patent." (Italics ours.)

Diametrically opposed to the holding of the Second Circuit Court of Appeals that the McMichael invention is distinguished from the Supreme Court decision in the

Gomery case is Judge Bourquin's ruling in the present case:

> "The instant case cannot be distinguished in principle from *Concrete etc. Co.* v. *Gomery*, 269 U. S. 177, wherein it is held that appliances and method of conveying mobile substances by gravity extended to concrete when it came into use, and a subsequent patent to thus convey concrete is invalid."
>
> "For gravity, substitute compressed air, and that case 'reads' on this." (R., Vol. II, p. 616.)

And in its decision herein the Ninth Circuit Court of Appeals very evidently agrees with Judge Bourquin and disagrees with the Second Circuit Court of Appeals, for it cites the Gomery case in justification of its citation of the Duckham British patents against the McMichael patent,—the Duckham patents which were concerned with a problem entirely different from that of McMichael and which disclosed devices wholly lacking the McMichael structure and which, for many reasons, were totally incapable of handling concrete.

IV.

The Conflict As To the Proof Required to Establish Prior Invention and Public Use.

As previously pointed out, the alleged 1905 experiment of Leake admittedly lacked McMichael's essential high velocity nozzle and would not be anticipatory even if proved. But it certainly is not proved.

The contentions of respondents with reference to the alleged prior invention and use by Leake in 1905 of a non-existent structure illustrated by a sketch (Defendants' Exhibit No. 127) made by Leake on the witness stand in 1927, rests solely upon the deposition of Leake, uncorroborated by any other witness and unsupported by

any contemporary physical or documentary evidence of any kind.

The Ninth Circuit Court of Appeals has stated the startling conclusion that prior invention and use may be established by such evidence, and in so doing disregards the controlling Supreme Court decisions and conflicts with the decision of the Second Circuit Court of Appeals in the Powers-Kennedy case.

Judge Bourquin in supporting the contention that Leake was a prior inventor and user of the McMichael machine, said:

> "the evidence in quality and quantity inspires confidence and constrains conviction of the truth of the fact and beyond reasonable doubt." (R., Vol. II, p. 619.)

And the Ninth Circuit Court of Appeals approved Judge Bourquin's finding:

> "We find no ground for disturbing the trial court's conclusion."

Petitioner has been unable to find a single reported case where any patent has been held invalid by any court because of an alleged prior invention or use said to be established by the testimony of a single witness in the absence of corroborating contemporary physical or documentary evidence.

The cases cited by the Ninth Circuit Court of Appeals are not in point. Thus, for example, the Ninth Circuit Court of Appeals says:

> "That the testimony of one witness may be sufficient in such a case is held in *Mayer* v. *A. & H. G. Mutschler,* 248 Fed. 911, 914, where it was said that one witness may suffice if the surrounding circumstances are confirmatory."

That the said case of *Mayer* v. *Mutschler* is not in point is clearly revealed by a portion of the opinion therein, reading as follows:

"The rules as to prior use are severe and rightfully so and Archbald is a witness hostile to plaintiff; **but the existence of the machine is not denied,** its date of erection **proved by other testimony than Archbald,** as also is its unchanged condition, and still another witness swears that it was in 1911 as it is now."

It is clear that in *Mayer* v. *Mutschler* the patent in suit was not held invalid upon the basis of any such evidence as the uncorroborated deposition of Leake which is present in the instant case.

The Ninth Circuit Court of Appeals did not cite, and apparently overlooked, the following controlling Supreme Court cases which prescribe the kind and degree of proof necessary to establish prior invention and public use:

"As we have had occasion before to observe oral testimony, unsupported by patents or exhibits, tending to show prior use of a device regularly patented is, in the nature of the case, open to grave suspicion. The Barbed Wire Patent, 143 U. S. 275. Granting the witnesses to be of the highest character, and never so conscientious in their desire to tell only the truth, the possibility of their being mistaken as to the exact device used, which, though bearing a general resemblance to the one patented, may differ from it in the very particular which makes it patentable, are such as to render oral testimony peculiarly untrustworthy; particularly so if the testimony be taken after the lapse of years from the time the alleged anticipating device was used. If there be added to this a personal bias, or an incentive to color the testimony in the interest of the party calling the witness, to say nothing of downright perjury, its value is, of course, still more seriously impaired. **This case is an apt illustration of the wisdom of the rule requiring such anticipations to be proven by evidence so cogent as to leave no reasonable doubt in the mind of the court,** that the transaction occurred substantially as stated. The very exhibit produced by the witness Heller contradicted, so far as it could contradict, his testimony, and the witnesses who ought to have corroborated his story, gave a version which

showed it to be untrue in more than one important particular." *Deering* v. *Winona Harvester Works*, 155 U. S. 286, 300.

"It is true that some witnesses testify that they realized before Eibel's application that speeding up the stock to equal velocity with the wire would solve the difficulty and aid the speed. But there is not a single written record, letter or specification of prior date to Eibel's application that discloses any such discovery by anyone, or the use of the pitch of the wire to aid the speed of the machine. **The oral evidence on this point falls far short of being enough to overcome the presumption of novelty from the granting of the patent.** The temptation to remember in such cases and the ease with which honest witnesses can convince themselves after many years of having had a conception at the basis of a valuable patent, are well known in this branch of law, and have properly led to **a rule that evidence to prove prior discovery must be clear and satisfactory.**" *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45, 60 (1922).

"This court has pointed out that oral testimony tending to show prior invention as against existing letters patent is, in the absence of models, drawings, or kindred evidence, open to grave suspicion; particularly if the testimony be taken after the lapse of years from the time of the alleged invention. *Deering* v. *Winona Harvester Works*, 155 U. S. 286, 300." *T. H. Symington Company* v. *National Malleable Castings Company et al.*, 250 U. S. 383, 386.

In further contrast with the holding of the Ninth Circuit Court of Appeals that prior invention and use was established by the uncorroborated testimony of Leake, is the language of the Second Circuit Court of Appeals, in the Powers-Kennedy case, in rejecting an alleged prior public use to which *two* witnesses testified. The Second Circuit Court of Appeals said:

"This use was of a machine which Artingstall and Fanning said that they saw laying a concrete floor in 1903, subsequently changing the date to 1904. That was twenty-two years before they gave their

testimony, and there was no documentary corroboration of any kind. . . . If we may invalidate a patent upon such prior uses so proved, no patent would be safe. A prior use such as constitutes an anticipation was not proven with the degree of certainty which the courts require. See *Deering* v. *Winona Harvester Works,* 155 U. S. 286, 300; *Internat. Cork Co.* v. *New Process Cork Co.,* 6 F. (2) 420, 424 (C. C. A. 2); *De Laski & Thropp Co.* v. *Fisk Rubber Co.,* 203 F. 986 (C. C. A. 1)."

The holding by the Ninth Circuit Court of Appeals that prior invention and public use may be made out by the deposition of a single witness, uncorroborated by any other witness or by any contemporary physical or documentary evidence is in conflict with the decisions of the Supreme Court, is revolutionary in its nature, and if not corrected by your Honors will constitute a most dangerous precedent.

V.

The Conflict As to the Anticipatory Effect of Discarded and Abandoned Experiments.

The alleged 1905 experiment of Leake was unquestionably discarded and abandoned almost immediately after it was made.

Leake says:

"A. No; that was nothing but a crude machine put up there to see whether I could put concrete up in the air.

"Q. What happened after you used that?

"A. I tore it down.

"Q. Did you keep that?

"A. No. It was nothing only a lot of two by four stuff put in with hoops.

"Q. So that is not in existence now?

"A. Oh, no.

"Q. Do you know of any other pictures or blue-

prints of that device other than the one you have referred to here?[1]

"A. No." (R., Vol. II, p. 586.)

In striking contrast, the Second Circuit Court of Appeals in the Powers-Kennedy case says:

> "It is one thing to say that a continuous use to date may be found on oral testimony to have started at a given time, and quite another to say that such testimony is enough when it describes only a casual use, abandoned thereafter, and never entering into the art until after the patent in suit was applied for. . . . Such casual and abandoned uses do not contribute to the stock of knowledge which makes up the art. If we may invalidate a patent upon such prior uses so proved, no patent would be safe."

The language of the Second Circuit Court of Appeals is particularly applicable to Leake's alleged casual and abandoned experiment of 1905. Leake *after* McMichael's filing date did apply for a patent. Leake's patent application, however, was essentially different from his abandoned experiment of 1905. The patent application included McMichael's essential velocity nozzle. The alleged abandoned experiment of 1905 did not include that essential element. This, we think, was the salient reason why Leake's alleged 1905 experiment was an abandoned failure and why the world had to wait for McMichael to produce a practical pneumatic concrete placer.

---

[1] The "one you have referred to here" is the sketch made by Leake himself in connection with his testimony in 1927 (Exhibit Book, pp. 693, 694).

VI.

The Conflict As To What Constitutes Fair and Competent Evidence.

The Ninth Circuit Court of Appeals, being unable to find a particle of *contemporary* documentary evidence to corroborate the testimony of Leake concerning his alleged prior use in 1905, quotes from a patent application of Leake, filed *after* McMichael's filing date, as supposed corroboration of Leake's testimony concerning events said to have happened *before* McMichael's filing date. McMichael's patent application was filed on January 14, 1907. Yet the Circuit Court of Appeals regards a preliminary statement (affidavit) made by Leake in *1908* as acceptable corroboration of Leake's testimony concerning events said to be have transpired in 1905. The preliminary statement was filed in an interference between Leake and McMichael. The interference terminated favorably to McMichael because petitioner, which owned both applications, concluded that McMichael and not Leake was the inventor of the essential combination including the high velocity nozzle. That the interference was properly terminated is demonstrated by the fact that Leake does not claim in his deposition in this case to have conceived anything corresponding to the high velocity nozzle before McMichael's filing date. Admittedly the 1905 experiment did not include it.

The only conceivable proper purpose to which the Leake preliminary statement could have been put in the present case would have been to impeach or discredit Leake as a witness. But as evidence to sustain the contention that Leake was a prior inventor, it is palpably incompetent. Originating *after* McMichael's filing date, it cannot establish events preceding McMichael's filing date.

Furthermore, the Ninth Circuit Court of Appeals regards certain statements made in Leake's patent application in 1908, by Leake's *attorney*, who does not even pretend to have had first-hand knowledge of the facts, as competent evidence corroborating the verbal testimony as to alleged happenings in 1905. The attorney was not called as a witness. These are simply laudatory statements made by the attorney in behalf of his client. All of this argumentative laudation is consistent with the fact that Leake made the apparatus of his patent application *after McMichael's filing date.* The attorney did not say when Leake's use of his patent application machine was made. Yet the Ninth Circuit Court of Appeals regards the laudatory statements made in 1908, after McMichael's filing date, as evidence that a device made in 1905 was practical and satisfactory.

There is no theory upon which the unsworn statements of Leake's patent attorney in an *ex parte* prosecution of a patent application can be considered competent evidence for or against either of the parties to this litigation.

In the Powers-Kennedy case the defendants attempted unsuccessfully to persuade the courts to give favorable consideration to the same kind of incompetent evidence which has been favorably considered by the Ninth Circuit Court of Appeals in this case.

The Second Circuit Court of Appeals said:

> "The new defense of prior use was held by the district court not sufficiently proved; and with this we agree. This use was of a machine which Artingstall and Fanning said that they saw laying a concrete floor in 1903, subsequently changing the date to 1904. That was twenty-two years before they gave their testimony, and there was no documentary corroboration of any kind. **It is true that in 1918 Artingstall described very generally before a meeting of engineers that this process was practiced in 1903,**

but that can not be deemed documentary corroboration."

That the Circuit Court of Appeals for the Second and Ninth Circuits are in disagreement as to the fairness and competency of the kind of evidence under consideration is even further emphasized by the following quotation from the decision of the Second Circuit Court of Appeals in the case of *General Electric Co.* v. *P. R. Mallory & Company,* 298 Fed. 579, 586, where we find pungently stated the rule which is supported by the great weight of authority:

> "The effort of what ought to be those very plastic regulations called rules of evidence is to produce testimonial matter relevant, competent, pertinent, material and fair, and of these adjectives emphasis is to be laid upon the last, quite as much as upon any of the others. It is *fair* to produce a man whose mental concept and reduction thereof to practice lies at the basis of a litigation, and subject him to the fiercest cross-examination, using his previous admissions and statements as the basis thereof; but anything more unfair than to introduce that man's statements *inter alios,* without the possibility of further examination, we cannot imagine.
>
> "The offer of various parts of the file-wrapper of the patent at bar, consisting of attorneys' arguments, statements or deductions, was flatly opposed to the rule so often stated in this circuit, and last restated in *Spalding* v. *Wanamaker,* 256 Fed. 530, 167 C. C. A. 602. To that ruling we adhere, and deem further discussion unnecessary."

VII.

The Conflict As to the Scope of the Claims of the McMichael Patent.

In his opinion Judge Bourquin (the trial judge), after holding that McMichael had not "discovered, invented, combined or made anything new" said:

> "That serves to dispose of the case, and the defense of non-infringement needs no more consideration than to note that Hackley's apparatus is a different combination than McMichael's, has no upright cylindrical hopper bottomed container, is without the U bend, employs no upper air save some incidental back pressure, does not discharge slug fashion as claimed is the invention of McMichael, and so, does not infringe." (R., Vol. II, p. 621.)

The quoted sentence sets forth propositions which are in conflict with the Second Circuit decisions involving the McMichael patent. The Ninth Circuit Court of Appeals, in reviewing Judge Bourquin, did not discuss the question of infringement.

Judge Bourquin's finding that Hackley's (defendants') apparatus does not infringe because it "has no upright cylindrical hopper bottomed container" is only another way of saying that McMichael's machine is no longer a McMichael machine if turned over on its side. A horizontal machine is in effect nothing more nor less than a McMichael machine of the vertical type turned on its side to save head room. Judge A. N. Hand and the Second Circuit Court of Appeals very definitely disagree with Judge Bourquin's finding that McMichael's claims do not extend to and cover a horizontal machine. The device which was found to infringe in the Ulen case was of the horizontal type.

When Judge Bourquin held the defendants' machines not to infringe the McMichael patent because being

"without the U bend" he was referring to a minor feature of construction to which McMichael's claims are *not* limited. That Judge A. N. Hand and the Second Circuit Court of Appeals do not agree that McMichael's patent is limited to a device including this U bend is demonstrated by the fact that defendants' devices in the Ulen and Powers-Kennedy cases were without this element.

When Judge Bourquin said that defendants' machines do not infringe because they "employ no upper air save some incidental back pressure" he was again conflicting with the findings of Judge A. N. Hand and the Second Circuit Court of Appeals in the Powers-Kennedy case. In the present case, as in the Powers-Kennedy case, the defendants urged that infringement was avoided because the air pressure above and behind the mass of concrete in the container was not established by an air pipe intended *solely* for that purpose. In each case the defendants claimed that the inevitable pressure above and behind the mass of concrete was "incidental back pressure." Judge A. N. Hand in the Powers-Kennedy case definitely decided this question in favor of the McMichael patent, as follows:

> "All of the claims were infringed until the Powers-Kennedy structure was impaired in the hope of avoiding infringement. After ceasing to introduce pressure behind the mass of concrete by means of closing the upper valve, it is true that some of the claims are not met, yet some of them are. There is undoubtedly a pressure behind the mass in defendant's machine far greater than ordinary air pressure and varying according to the freedom with which the air in the outlet tube is passing through it." (Exhibit Book, p. 31.)

That the Second Circuit Court of Appeals agreed with Judge Hand is clearly revealed by its opinion affirming his decree.

And when Judge Bourquin held that defendants' machines do not infringe because they do "not discharge slug fashion as claimed is the invention of McMichael" he was reading into McMichael's claims a limitation which they do not contain and which the Second Circuit Court of Appeals has said should not be read into them. The so-called "slug theory" is not included in the claims of the McMichael patent. It is only a theory which has been advanced in explanation of the incontrovertible fact that McMichael's definitely located and peculiarly functioning nozzle does enable these pneumatic concrete placers to transport concrete pneumatically (which would be impossible if it were either disintegrated or propelled in a body) and without separating its aggregates.

The Second Circuit Court of Appeals in the Powers-Kennedy case says:

> "The patent says nothing which commits the patentee to the slug method of operation. . . .
>
> "Moreover, several of the claims in suit are for the apparatus, or machine, and if they are infringed it is enough for the purposes of this suit, whether the machine discharges its concrete kinetically or in successive slugs. . . . But whether the concrete goes forward as we imagine, or in some other manner, there is no sufficient reason to suppose that defendants' machine does not operate in the same manner as plaintiff's, whatever that manner may be."

Summarizing:

It is the conclusion in the Ninth Circuit that McMichael's patent does not extend to a horizontal machine. The Second Circuit disagrees. It is the conclusion in the Ninth Circuit that McMichael's patent is limited to an apparatus including the "U bend." The Second Circuit disagrees. It is the conclusion in the Ninth Circuit that a machine does not infringe the McMichael patent if in such machine the pressure above and behind the mass of

concrete in the container is "back pressure." The Second Circuit disagrees. It is the conclusion in the Ninth Circuit that McMichael's claims are limited to a machine which discharges "slug fashion." The Second Circuit disagrees and holds that infringement is made out by showing the identity in structure between the device of the McMichael patent and a device charged to infringe,—that the devices which are of like construction operate in the same manner, whatever that manner may be.

The Facts Before the Two Circuit Courts of Appeals Were Substantially the Same in Every Essential Respect.

In only one single sentence does the opinion of the Court of Appeals for the Ninth Circuit allude to the four earlier decisions in the Second Circuit involving this same McMichael patent. This one sentence is as follows:

> "The decisions in *Concrete Mixing & Conveying Co.* v. *Ulen Contracting Corp.*, 12 Fed. (2) 929, and *Concrete Mixing & Conveying Co.* v. *The Powers-Kennedy Company*, relied upon by the appellant, were based on records widely different from that in the case at bar." (R., Vol. II, p. 678.)

This sentence may have been written in anticipation of a petition for a writ of certiorari, and in forehanded persuasion that it should be denied. This general assertion, however, is not supported by the citation of any wide or essential differences in the records of the several cases.

We say in reply to this general assertion merely that this statement contained in the opinion of the Ninth Circuit Court of Appeals is erroneous if it means anything more than the records are different in size and detail, due mainly to the astounding number of irrelevant prior art

patents and publications and cumulative depositions, offered in evidence by the respondent in this case. It could always be said of any two records in any two cases that they were "widely different,"—if regard be had only for immaterial detail.

The foregoing analysis of the conflicts between the two Circuit Courts of Appeal shows conclusively that the facts before the two courts were the same in every essential respect.

Conclusion.

In view of the foregoing, a writ of certiorari should issue.

Respectfully,

LYNN A. WILLIAMS,
CLIFFORD C. BRADBURY,
ALBERT G. MCCALEB,
Counsel for Petitioner.

STEPHEN J. COX,
Of Counsel.

APPENDIX.

OPINIONS AND CERTAIN DECREES OF THE COURTS OF THE SECOND CIRCUIT WITH WHICH THE NINTH CIRCUIT IS IN CONFLICT.

EXHIBIT "A."

Opinion of Honorable Learned Hand Overruling Segregated Defense—Ulen Case.

UNITED STATES DISTRICT COURT.

SOUTHERN DISTRICT OF NEW YORK.

Concrete Mixing and Conveying Company, *Plaintiff*,
against
Ulen Contracting Corporation, *Defendant*.
} E 26-325.

Sur motion by defendant to segregate and try separately a defense in the answer.

JAMES L. STEUART for the motion.

STEPHEN J. COX opposed.

LEARNED HAND, D. J.: The defendant moves under Rule Twenty-nine to try separately the defense contained in the seventh article of the answer which alleges (*a*) that the patentee had abandoned the claims eventually allowed before their allowance, (*b*) that the new claims had no support in a supplemental oath, (*c*) that the plaintiff is estopped to deny the invalidity of the claims, (*d*) that the disclosure contained an abandonment of the claims, (*e*) that the application having been once abandoned was irregularly renewed. The motion to try out the issues I allowed (though I think the practise of doubtful expediency usually), and I have heard it on the file-wrapper, and assignments on file, which is the only evidence that the defendant wishes to put in in support of the defence. I shall consider the several points in the order in which they are presented in the answer.

(*a*) This point rests upon a misconception of authorities like *Leggett* v. *Avery*, 101 U. S. 256, *Goodyear Dental Vulcanite Co.* v. *Davis*, 102 U. S. 222, and *Cartridge Co.* v. *Cartridge Co.*, 112 U. S. 624, on the one hand and *Shepard* v. *Corrigan*, 116 U. S. 593, *Corbin etc. Co.* v. *Eagle Lock Co.*, 150 U. S. 40 and *Hubbell* v. *U. S.*, 179 U. S. 77 on the other. The first doctrine is that on reissue no claims can be inserted which had been made and rejected in the original application. The second is that in the interpretation of claims a patentee may not insist that they shall be read as equivalent to claims in whose rejection in the Patent Office he acquiesced. Neither of these doctrines has anything at all to do with claims which have been once rejected and in substance resolicited and allowed while the application is still pending. So far as I know there is not a syllable in the books to support the notion that an applicant may not renew his claims as often as he pleases and persuade the examiner that he was wrong in his rejection. On principle that is clearly his right. The patent is *in fieri* until it is allowed; the proceedings, as Mr. Cox well puts it, are negotiations between two contracting parties, till their conclusion open to modification by either side. When the bargain is struck the patent issues and the claims are frozen, but not before.

(*b*) The next objection is the absence of a supplemental oath, but as the matter incorporated was only new claims and did not concern the disclosure, no such oath was necessary. It is now settled in this circuit that new claims do not require a supplemental oath, *Westinghouse etc. Co.* v. *Metropolitan Electric Mfg. Co.*, 290 Fed. Rep. 661 (C. C. A. 2).

(*c*) and (*d*). The third and fourth objections I consider together; they depend upon the supposed disclaimer contained in the disclosure. The patent is for an inven-

tion of transporting concrete pneumatically. Through one pipe air pressure is created on the surface of the concrete, through another there is a supplementary pressure added just at the point of discharge from the chamber to the transporting pipe. Each of the claims in suit except claim twenty-two contains as an element this second or auxiliary pipe which empties direct into the discharge duct. This differentiates the invention claimed from the methods of delivering concrete which are disclaimed as old in the passages cited. The earlier devices were generic of which the patent in suit was a species. The twenty-second claim has not this element but is distinguished from the old art as described in the disclaimer at least by the fact that the lines of pressure from the surface must extend direct into the discharge duct. The claim may be bad, it is true, but not because it is disclaimed in the patent.

(*e*) The last point is that the application was irregularly renewed after it had lapsed. The irregularities are (1) that the renewal was made in the name of the original applicant after he had conveyed, (2) that it did not adopt the original petition, and (3) that it "renewed" the application and did not pray for its renewal and that no hearing was had or evidence given that the delay was unavoidable. The title to the invention at the time of the petition to renew it was in a trustee for the benefit of four persons of whom one was McMichael, the original applicant, and the petitioner for renewal. Revised Statutes §4897 gives the right to apply for renewal to "any person who has an interest" in the invention. McMichael still had an interest and could apply.

The renewal petition adopted the "specifications, oath and drawings" theretofore filed. Apparently Patent Office Rule 176 says that the renewal application may

adopt these and the "petition" as well. How the renewal petition can adopt the lapsed petition I do not see; a new petition is required and it is a meaningless absurdity to require that it shall adopt the original petition.

The objection that the petition "renewed" the application instead of praying to renew it is frivolous. There is no evidence that the Patent Office gave no hearing to the renewal application and no case that I know which holds that the sufficiency of the evidence can be reviewed by a court.

The defense is overruled and a decree may pass striking it from the answer.

LEARNED HAND,
D. J.

October 13, 1923.

EXHIBIT "B."

Opinion of Honorable Augustus N. Hand at Final Hearing—Ulen Case.

No. 1094.

UNITED STATES DISTRICT COURT,

SOUTHERN DISTRICT OF NEW YORK.

Concrete Mixing & Conveying Company,
Complainant,
vs.
Ulen Contracting Corporation and Shandaken Tunnel Corporation,
Defendants.

Stephen J. Cox, Solicitor for Complainant.
Stephen J. Cox and A. G. McCaleb, Counsel.
James L. Steuart, Solicitor and Counsel for Defendant, Ulen Contracting Corporation.
Frank S. Moore, Solicitor for Defendant, Shandaken Tunnel Corporation.
James L. Steuart, Counsel.

AUGUSTUS N. HAND, District Judge:

This is a suit for infringement of U. S. Letters Patent No. 1,127,660, to John H. McMichael, granted February 9th, 1915, Claims 2, 4, 6, 17, 21, 22, 28, 34 and 35.

The invention has for its object to provide a method of and apparatus for elevating and transporting concrete. The patentee describes concrete in the specification as "a composition containing relatively large pieces of rock or stone as uniform in size as possible, together with predetermined proportions of sand, cement and water."

Pneumatic pressure is used to compress the concrete into a restricted conduit pipe and then additional pressure by means of a jet of compressed air is applied to the mass near the entrance of the conduit pipe, thereby pushing the mass into and along the conduit. The McMichael invention is a most interesting one and has apparently met with general acceptance. Engineers at first distrusted the possibility of lifting and conveying concrete large distances by the McMichael device. The very material would be likely to clog any long pipe line. Moreover the weight would be so great if conveyed as a mass by means of pressure from the rear, that too great pressure for safety would be required, if, indeed, enough could be applied where the distance was long and concrete, as in some cases, was lifted eighty feet. Various attempts to convey sand appear in a number of patents, and in the Goldie Patent No. 707,840, sand was ejected under railroad ties by steam pressure.

In the Farnham Patent No. 747,396, there was a sandblast apparatus shown where the sand was carried into the discharge pipe by gravity aided by compressed air and then ejected by an air blast nozzle entering the discharge pipe in the general direction thereof. The patent to Sticker No. 758,118 is likewise for a sandblast.

None of these patents, in my opinion, would teach anyone with imagination and talents short of a real inventive faculty to instal a conveyor which would obviate the delay and expense of laying concrete by hand about the forms on which a tunnel is built. They were kinetic devices for floating light materials. This was in substance so even in the case of the Goldie patent where dry cement, or cement mixed with sand or gravel, was ejected from a short hose by an air or steam waterblast. It is not accomplished by a heavy air pressure as in the patent in suit, but by air or steam velocity.

In the McMichael patent the second blast of compressed air at once cuts the concrete mass and shoves along the segment of concrete. The segment to be shoved along is of comparatively small weight and dimension so that it can be carried without clogging the discharge pipe. Mr. Kirkland, the chief engineer of the complainant, described this at page 9 of the record:

> "Q. 42. What is the effect as you have observed the operation of the machine of working the jet at the bottom directed at a line or an angle to the travel of the material in passing from the main vessel?
>
> "A. The air breaks up or penetrates the mass as it goes toward the outlet, detaching portions of it, so that these portions will present a surface to the oncoming booster jet so that they may be forced through the pipe.
>
> "Q. 43. And are these batches solid or in detached portions?
>
> "A. They come on in waves. Sometimes the successive portions of each batch follow each other so rapidly through the pipe that to the casual observer it would be almost impossible to tell whether it was a continuous stream or successive batches, but in long pipe lines, the successive batches are more pronounced and one observing them will note a wave,—that the material comes in waves.
>
> "Q. 44. How far has concrete been conveyed and placed in this apparatus from the apparatus itself?
>
> "A. On the Twin Peaks tunnel in San Francisco we placed it at a distance of 4,900 feet from the machine."

Mr. Bateman, the superintendent of the well known contractors Booth & Flinn, confirmed the foregoing testimony as to the discharge of the concrete from the complainant's machine in sections.

Complainant's expert, Frederick Ray, said:

> "The net result of that is that it is possible to handle this concrete in slugs through a long pipe with a comparatively low pressure of air, that is a pressure of air around 100 pounds whereas to force it as

a continuous stream through such a pipe, might take thousands of pounds or it might even be impossible, but certainly concrete can be forced through a certain length of pipe." (Minutes, p. 91.)

Mr. Ray points out the portion of the specification which indicates that the inventor understood these advantages of his invention. McMichael says at page 2, lines 45 to 100 of the specification:

"It will be observed that the upper air pipe 8 serves merely to supply air to the upper part of the chamber 1, the pressure of the air being uniformly applied over the entire upper surface of the mass. The lower pipe 10, however, serves to direct a jet of air moving at a considerable velocity directly against portions of the mass as they move toward and into the discharge duct. The two pipes thus act in very different ways, the upper pipe supplying air which acts by pressure and the lower pipe supplying air which acts by velocity. On account of the presence of large and small particles, and on account of the presence of water, a mass of concrete forming materials (whether completely mixed or not) is relatively compact and impervious to air, and on this account the upper air body acts by applying a uniform pressure to the entire upper mass surface and without any substantial penetration of the air itself to the interior of the mass. Air from the lower pipe 10 may force itself into the body of the mass, and the relatively small air jet acting upon the relatively large stream of outward moving materials directly engages with the submasses to push them along. This action of the two air bodies in my apparatus is to be contrasted with the action of air in earlier devices which were so constructed that light materials such as grain or ashes could be caught in large moving air bodies and carried along in suspension with each particle separated from the others. One of the strongly marked and novel matters incident to this provision of the pipe 10 for introducing air directly into the discharge pipe, whether considered by itself or considered as supplemental to the agency such as the air from pipe 8 tending to effect down-

> ward and forced propulsion of the entire mass, is this, that the rapidly moving air from pipe 10 acts upon sub-masses, successively of the general mass, at points near those where they enter to delivery pipe, the result being that the thorough commingling of the ingredients (rock pieces, sand, cement and water) well understood by the engineer to be essential to a perfect concrete, can be attained with great rapidity and with a perfect, uniform, distribution of the various ingredients as concerns the relative positions of all component particles."

A device for transporting sand, ashes or coal even by means of an apparatus having a structural resemblance to complainant's device nearer than we find furnishes no anticipation of the patent and McMichael's conveyor when applied to concrete is not objectionable as a double use. *Concrete Appliance Co.* v. *Meinken,* 262 Fed. at p. 964. As Judge Denison remarked in the foregoing case:

> "Certainly the art of loading coal into a ship for fuel is not the same art as that of distributing wet concrete to a building structure; nor is the analogy very close." See also *Hobbs* v. *Beach,* 180 U. S. at p. 389.

The appreciation by the inventor of the necessity of limiting the concrete to be conveyed to sections of moderate size and weight and his method by the second air jet of securing the cutting off of a segment from the mass of concrete and a propulsion of this segment through the discharge pipe involves invention of a high order. His device has displaced all other methods for rapidly and economically conveying, lifting and placing concrete at long distances from the initial source of supply and has been used in numerous great enterprises. In such circumstances his claims should be read broadly and given a fair range of equivalents. When so read I think the defendants plainly infringe.

The process claims are limited to no particular form of apparatus so that the contention that they are for a mere function seems without merit. *Expanded Metal* v. *Bradford*, 214 U. S. 366; *Buffalo Forge Co.* v. *City of Buffalo*, 255 Fed. 83.

I find claims 2, 4, 6, 17, 21, 22, 28, 34 and 35 valid and infringed, and grant an interlocutory decree to the complainant with the usual reference.

A. N. H.

Aug. 4, 1925. *D. J.*

EXHIBIT "C."

Order of Affirmance by Circuit Court of Appeals for the Second Circuit—Ulen Case.

UNITED STATES OF AMERICA, ss.

The President of the United States of America: To the Honorable the Judges of the District Court of the United States for the Southern District of New York,

GREETING:

WHEREAS, lately in the District Court of the United States for the Southern District of New York, before you or some of you, in a cause between Concrete Mixing & Conveying Company and Ulen Contracting Corporation and another, a decree was entered in the office of the Clerk of said Court in the words and figures following to wit:

"This cause came on to be heard at this term, and was argued by counsel; and thereupon, upon consideration thereof, it was

ORDERED, ADJUDGED AND DECREED AS FOLLOWS:

1. That Letters Patent of the United States No. 1,127,669 granted to John H. McMichael February 9, 1915, for Method of and Apparatus for Transporting and Treating Concrete, the same being the letters patent in suit, are good and valid; that the said John H. McMichael was the original, first and sole inventor and discoverer of the improvements described and claimed in the said letters patent and set forth in the specification thereto annexed; that the plaintiff, the Concrete Mixing & Conveying Company, is the sole owner of said Letters Patent and is entitled to recover damages and profits for all infringements thereof; that the defendants Ulen Contracting Corporation and Shandaken Tunnel Corporation have infringed the said letters patent and particularly

claims 2, 4, 6, 17, 21, 22, 28, 34 and 35 thereof, and the exclusive rights of the plaintiff thereunder by using and employing a method and an apparatus for elevating and transporting concrete, practicing and embodying the invention of the said letters patent and the improvements patented as aforesaid, as charged in the bill of complaint herein.

2. That a perpetual injunction issue in this suit against the said defendants, restraining them, and each of them, their officers, agents, servants and employees, and all persons acting under or for them, from directly or indirectly making, selling, using or otherwise disposing of apparatus for elevating and transporting concrete or utilizing or practicing any method for elevating and transporting concrete embodying or realizing the invention or improvements of said letters patent No. 1,127,660.

3. That the plaintiff do recover of the defendants, the profits, gains and advantages which the said defendants, and each of them, have realized, or which have arisen or accrued to them on account of or in connection with the said infringement, and the damages resulting from said infringement.

4. That it be referred to William Parkin, Esq., of the City, County and State of New York, as Master *pro hac vice*, to ascertain, take and state and report to the court an account of the extent and circumstances of the use and employment of the said method and apparatus, embodying said invention and improvements as described in and secured by said letters patent No. 1,127,660, the number of such apparatus used and employed and the quantity of concrete placed by the defendants and each of them with such apparatus, and by the use or employment of it and the said method, and also the gains, profits and advantages which the said defendants and each of them has received or which have arisen or accrued to them, from the said infringement, and the damages which the plaintiff has suffered by reason of said infringement, the matter of the increase of damages, as prayed in the bill of complaint, to be left until the coming in of the said Master's report.

5. That the plaintiff on such accounting have the right to cause the examination of the defendants' officers, agents and employees, *ore tenus* or otherwise,

and also to the production of their books, records, accounts, vouchers and documents, and that they attend for such purpose, before said Master, from time to time, as said Master shall direct, and file with the said Master an account of the said profits, gains and advantages in detail, giving the items, dates and details and the extent of the use and employment of the said apparatus and method and the quantity and amount of concrete placed, the number of apparatus used, and the manner in which the same were used, and such other information relating thereto as said Master shall direct.

Dated August 20th, 1925.

AUGUSTUS N. HAND,
U. S. D. J."

as by the inspection of the transcript of the record of the said Court, which was brought into the United States Circuit Court of Appeals for the Second Circuit, by virtue of an appeal agreeably to the Act of Congress, in such case made and provided, fully and at large appear.

And, whereas, in the present term of October, in the year of our Lord one thousand nine hundred and twenty-five the said cause came on to be heard before the said Circuit Court of Appeals for the Second Circuit, on the said transcript of record, and was argued by counsel. On consideration whereof, it is hereby ORDERED, ADJUDGED AND DECREED that the decree of said District Court be and it is hereby affirmed with costs taxed at the sum of $25.00.

You, therefore, are commanded that such further proceeding be had in said cause, in accordance with the decree of this court as according to right and justice, and the laws of the United States, ought to be had, the said appeal notwithstanding.

WITNESS, the Honorable WILLIAM H. TAFT, Chief Justice of the United States, the 19th day of May, in the year of our Lord one thousand nine hundred and twenty six.

WM. PARKIN.
Clerk of the United States Circuit Court of Appeals, for the Second Circuit.

COSTS OF APPELLEE:

Clerk	$ 5.00
Printing record	
Attorney	20.00
	25.00

(Seal U. S. Circuit Court of Appeals, Second Circuit).
O. K.—C. E.
Filed Nov. 12, 1926.
A true copy.

ALEX GILCHRIST, JR.,
Clerk.

COST OF APPELLEE:—In No. 332.

Filing brief $5.00	5.00
Attorney's docket fee	20.00
	25.00

Teste: WM. PARKIN,
Clerk United States Circuit Court of Appeals, Second Circuit.
ALEX GILCHRIST, JR.,

A true copy.
(Seal)
Clerk.

EXHIBIT "D."

Opinion of Honorable Augustus N. Hand on Final Hearing—Powers-Kennedy Case.

#1177.

UNITED STATES DISTRICT COURT,

SOUTHERN DISTRICT OF NEW YORK.

Concrete Mixing & Conveying Co., *Complainant,*
against
Powers-Kennedy Contracting Corporation and Anthony G. Fleck, *Defendants.*
} E 30/294.

Stephen J. Cox, Solicitor and Counsel for Complainant.
John D. Morgan, Solicitor for Defendants, John D. Morgan and Alan M. Johnson, Counsel.

AUGUSTUS N. HAND, District Judge:

This is an attempt to retry the issue determined in the case of *Concrete Mixing & Conveying Co.* v. *Ulen Contracting Corporation,* 12 Fed. (2d) 929, 931. The main reliance is upon a prior use which is alleged to have occurred over twenty years ago. No contemporary sketches are produced and the two witnesses attempt to describe from memory a mechanism which was not used except on two occasions. If such a practical device as that of the patent in suit had been employed, it is hardly likely that a contractor used to conducting large enterprises would not have sought a patent, or at least have taken advantage of something which in recent years has met with signal success. I am not satisfied that the defendants have established the prior use.

Aside from this new proof the defendants rely on the old contention made in the earlier case that their device is purely kinetic. I do not regard it as theoretically probable that masses of concrete containing gravel stones of a diameter running to one and a half inches can be blown long distances by compressed air and I think the testimony of Mr. Ray that he could detect the passage of a series of slugs when he put his ear to the outlet pipe is the more probable testimony. Moreover, if air were floating the concrete it would be bound to pass through the pipe and the pressure would be so rapidly reduced that the heavier portions would be left in the pipe.

All of the claims were infringed until the Powers-Kennedy structure was impaired in the hope of avoiding infringement. After ceasing to introduce pressure behind the mass of concrete by means of closing the upper valve, it is true that some of the claims are not met, yet some of them are. There is undoubtedly a pressure behind the mass in defendants' machine far greater than ordinary air pressure and varying according to the freedom with which the air in the outlet tube is passing through it. As each slug was discharged, the pressure in the discharge pipe would lessen and the pressure behind the mass amounting to something like thirty pounds would force a further slug into the outlet. If this were not so, the high pressure through the discharge pipe would hold back the concrete.

As for the point raised that patents for kinetic devices are pertinent prior art, it is answered by the fact that neither the patent in suit nor the defendants' device are kinetic in operation.

The complainant is entitled to an interlocutory decree with the usual reference, the same to be settled on notice.

A. N. Hand, D. J.

November 8, 1926.

EXHIBIT "E."

Interlocutory Decree—Powers-Kennedy Case.

UNITED STATES DISTRICT COURT,

SOUTHERN DISTRICT OF NEW YORK.

Concrete Mixing & Conveying Co., *Complainant,*
vs.
Powers-Kennedy Contracting Corporation and Anthony G. Fleck, *Defendants.*
} Equity 30/294.

INTERLOCUTORY DECREE.

This cause came on to be heard at this term at final hearing on pleadings and proofs, and was argued by counsel for both parties; and now after due consideration thereof, it is Ordered, Adjudged and Decreed as Follows:

1. That the plaintiff is the sole and exclusive owner of United States Letters Patent No. 1,127,660 for Method of and Apparatus for Transporting and Treating Concrete, granted February 9th, 1915, to John H. McMichael, assignor to the plaintiff, the same being the letters patent in suit, and also of all claims and demands in law and in equity for any and every infringement thereof.

2. That the said Letters Patent No. 1,127,660 are good and valid in law, and particularly as to claims 2, 4, 6, 17, 21, 22, 28, 34 and 35 (plaintiff having voluntarily waived a decree under the other claims recited in the stipulation between the parties in which the claims relied on are specified), and that the said John H. McMichael was the original, first and sole inventor and discoverer of the improvements described and claimed in the said Letters Patent and set forth in the specification thereunto annexed.

3. That the defendants, Powers-Kennedy Contracting Corporation and Anthony G. Fleck have infringed the said Letters Patent and particularly claims 2, 4, 6, 17, 21, 22, 28, 34 and 35 thereof, and the exclusive rights of the plaintiff thereunder by making and causing to be made, and using apparatus and employing a method for elevating and transporting concrete embodying and practicing the invention of said Letters Patent and the improvements patented as aforesaid, as charged in the Bill of Complaint herein.

4. That a perpetual injunction issue in this suit against the said defendants, restraining them, and each of them, their officers, agents, servants and employees, and all persons acting under or for them, from directly or indirectly making, selling, using, or otherwise disposing of apparatus for elevating and transporting concrete or utilizing or practicing any method for elevating and transporting concrete embodying or realizing the invention or improvements of said letters patent No. 1,127,660.

5. That the plaintiff do recover of the defendants the profits, gains, and advantages which the said defendants, and each of them, have realized, or which have arisen or accrued to them on account of or in connection with the said infringement, and the damages resulting from the said infringement, together with the costs of this suit to be taxed.

6. That it be referred to William Parkin, of the City, County and State of New York, as Master *pro hac vice*, to ascertain, take and state and report to the court an account of the extent and circumstances of the manufacture, sale and use and employment of the said method and apparatus, embodying said invention and improvements as described in and secured by said Letters Patent No. 1,127,660, the number of such apparatus made, sold, used and employed and the quantity of

concrete placed by the defendants and each of them with such apparatus, and by the use or employment of it and the said method, and also the gains, profits and advantages which the said defendants and each of them has received or which have arisen or accrued to them, from the said infringement, and the damages which the plaintiff has suffered by reason of said infringement, the matter of the increase of damages, as prayed in the bill of complaint, to be left until the coming in of the said Master's report.

7. That the plaintiff on such accounting have the right to cause the examination of the defendant Fleck, and the officers, agents and employees of the corporate defendant *ore tenus* or otherwise, and also to the production of their books, records, accounts, vouchers and documents, and that they attend for such purpose, before said Master, from time to time, as said Master shall direct, and file with the said Master an account of the said profits, gains and advantages in detail, giving the items, dates and details and the extent of the manufacture, sale, use and employment of the said apparatus and method and the quantity and amount of concrete placed, the number of apparatus used, and the manner in which the same were used, and such other information relating thereto as said Master shall direct.

AUGUSTUS N. HAND,
U. S. D. J.

Dated:
November 11th, 1926.

EXHIBIT "F."

Final Decree and Annexed Stipulation—Powers-Kennedy Case.

UNITED STATES DISTRICT COURT,

SOUTHERN DISTRICT OF NEW YORK.

Concrete Mixing & Conveying Co.,
Plaintiff,
vs.
Powers-Kennedy Contracting Corporation and Anthony G. Fleck,
Defendants.
} In Equity 30-294.

FINAL DECREE.

An interlocutory decree having been entered herein November 12th, 1926, adjudging Letters Patent in suit Nos. 1,127,660 valid and infringed as to claims 2, 4, 6, 17, 21, 22, 28, 34 and 35 thereof, directing the issuance of a perpetual injunction against the defendants for said infringement, awarding damages and profits to the plaintiff against the defendants for said infringement and costs, and directing an account of said profits and damages, and the parties hereto having waived further accounting proceedings and agreed upon the sum of Twenty-one thousand ($21,000) dollars as the amount of said costs and profits to be recovered by the plaintiff against the defendants and that a final decree for the same may be entered forthwith, as set forth in the annexed stipulation, filed and approved herewith, it is

ORDERED, ADJUDGED AND DECREED that the said defendants pay to the said plaintiff and the said plaintiff recover of the said defendants the said sum of Twenty-one thousand ($21,000) dollars, the amount of plaintiff's dam-

ages and defendants' profits, together with the costs of this suit to be taxed, and that the plaintiff have judgment and execution therefor against the defendants.

Dated March 19th, 1927.

KNOX,
U. S. D. J.

Approved as to form:

STEPHEN J. COX,
Plaintiff's Solicitor.

JOHN D. MORGAN,
ALAN M. JOHNSON,
Defendants' Solicitors.

UNITED STATES DISTRICT COURT,

SOUTHERN DISTRICT OF NEW YORK.

Concrete Mixing & Conveying Co., *Plaintiff,*
vs.
Powers-Kennedy Contracting Corporation and Anthony G. Fleck, *Defendants.*
} In Equity 30-294.

STIPULATION.

1. IT IS HEREBY STIPULATED AND AGREED by and between the parties hereto through their respective counsel, that the plaintiff's damages and the defendants' profits, and the amount to be recovered by the plaintiff, which plaintiff is entitled to recover from the defendants herein, is and is hereby fixed at the sum of Twenty-one thousand ($21,000) dollars exclusive of costs; that the accounting proceedings herein before Wm. Parkin, Esq., Special Master, shall be terminated forthwith, and the said sum fixed as the amount which would have been awarded to the plaintiff on the said accounting by the said Master;

and that no further or other accounting shall be had herein, but that this stipulation and agreement shall be in lieu of any such accounting and any report or award and confirmation of the same by the court.

2. IT IS FURTHER STIPULATED AND AGREED that the plaintiff may enter a final decree herein in the usual form, a copy of which is hereto annexed, awarding it the said sum of Twenty-one thousand ($21,000) dollars as damages and profits to be recovered from the defendants, with costs to be taxed, and have judgment and execution therefor, with the same force and effect as if the said sum had been awarded by the Master and his award confirmed by the court, said decree to be entered forthwith; but that the defendants shall have thirty days from the entry of such decree within which to take an appeal therefrom to the United States Circuit Court of Appeals for the Second Circuit, and give the supersedeas bond herein provided for, but said appeal shall not question the amount of damages and profits.

3. IT IS FURTHER STIPULATED AND AGREED that the defendants shall within thirty days from the entry of the said decree take an appeal therefrom to the U. S. Circuit Court of Appeals for the Second Circuit, and shall as a condition prerequisite to the allowance of such appeal furnish, serve and secure the approval of a bond with sufficient surety in and for the said amount and sum of Twenty-one thousand ($21,000) dollars, to secure the payment of that amount and costs if the decision of the District Court herein is affirmed by said Court of Appeals in whole or in part, so that one or more of the claims of the patent in suit is found to be valid and infringed, said bond to act as a supersedeas bond until the Mandate of the said Court of Appeals is issued, and said amount, and any judgment that may be entered therefor in this suit to be paid, with interest from the date hereof, forthwith,

and the said bond to guarantee such payment. The right to appeal after said thirty days is hereby waived.

4. IT IS HEREBY STIPULATED AND AGREED by and between the parties hereto, through their respective counsel, that immediately upon the approval and filing of the aforesaid supersedeas bond for Twenty-one thousand ($21,000) dollars, interest and costs, plaintiff will without delay cooperate with defendant in securing an Order from the court, and otherwise properly moving, to release the attachment or other lien which plaintiff has caused to be filed with the Comptroller of the City of New York, against the moneys now due and payable to defendant upon its contract with the City of New York for the construction of the Forty-second Street Subway, the purpose being to release said moneys due defendant as soon as plaintiff is protected by the filing of the supersedeas bond.

Dated March 17, 1927.

STEPHEN J. COX,
Plaintiff's Solicitor.

JOHN D. MORGAN,
ALAN M. JOHNSON,
Defendants' Solicitors.

EXHIBIT "G."

Opinion of Circuit Court of Appeals for the Second Circuit—Powers-Kennedy Case.

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

Concrete Mixing & Conveying Company,
Plaintiff-Appellee,
against
Powers-Kennedy Contracting Corporation and Anthony G. Fleck,
Defendants-Appellants.

Before: MANTON, L. HAND and SWAN, *Circuit Judges.*

Appeal from the District Court of the United States for the Southern District of New York.

Suit for infringement of claims Nos. 2, 4, 6, 17, 21, 22, 28, 34 and 35 of Patent No. 1,127,660 to McMichael, granted February 9, 1915, for "Methods of and Apparatus for Transporting and Treating Concrete." The defendant corporation was the builder of the Queensboro Crosstown Subway in Forty-second Street, New York City, and used in this work a machine for conveying and placing concrete by compressed air, which is alleged to infringe the patent in suit. The individual defendant furnished the machine to the corporation. From a decree finding the claims valid and infringed and awarding damages to the plaintiff, the defendants have appealed. Affirmed.

JOHN D. MORGAN,
Solicitor and of Counsel for Appellants.
ALAN M. JOHNSON,
Also of Counsel.
STEPHEN J. COX,
Solicitor and of Counsel for Appellee.
WILLIAMS, BRADBURY, MCCALEB & HINKLE,
of Counsel.

SWAN, Circuit Judge:

These same claims were held valid and infringed by the same district judge in *Concrete Mixing & Conveying Co.* v. *Ulen Contracting Corp.*, 12 F. (2d) 929. We affirmed that decree without opinion, *ibid*, 931. A detailed description of the patent in suit need not be here repeated. Subsequently, Judge Bourquin held the patent invalid in *Concrete Mixing & Conveying Co.* v. *R. C. Storrie & Co.*, 23 F. (2d) 131 (W. D. Wash.). It is urged that because of his decision and the case of *Concrete Appliance Co.* v. *Gomery*, 269 U. S. 177, as well as because of new matter introduced in this record, we should reconsider the validity of the patent.

The new matter is, of course, open to us and will be dealt with hereafter. The Supreme Court case, however, contains nothing, in our opinion, which casts doubt upon the correctness of the Ulen decision; in fact, it was before us when that decision was made. It holds, affirming the judgment of the Circuit Court of Appeals for the Third Circuit in 291 F. 486, that the Callahan patent, which covered an apparatus operating on the gravity principle for distributing "wet" concrete, was invalid, because it merely made use of known methods and appliances for the convenient handling of this recently accepted building material. The appellants' argument runs that since the Supreme Court emphasizes that old apparatus used for distributing water, grain, or coal was readily adaptable for handling concrete, so the prior art patents for blowing sand, grain or grout, which in the Ulen case were held not to invalidate McMichael's patent, should now be deemed complete anticipations of it. But the Gomery decision does not rest merely on the assumption that apparatus for coal and grain could have been used for wet concrete without inventive thought. Adaptations of old

carriers to handle concrete were shown to have been frequently made for several years before the application for the patent there in suit. The idea was already of common knowledge and was being applied generally. Therefore, Callahan's adaptation was not an invention. But that is a very different situation from the one before us in the Ulen case where nobody before McMichael had ever used a pneumatic apparatus to transport concrete. The Warren and Farnham sand-blast machines (Patents No. 671,303 and No. 747,396) could not have been so used without increasing the size of the discharge pipes and cutting off the sand-blast nozzles. To do this was to make a new machine, and one who thought of doing it would have had a new and inventive idea, that is, that of blowing concrete, which had not been done before. When that is so, the physical change in the apparatus need be very little to sustain a patent. The only reason why a new use is not patentable is that the law grants patents only for new things not for new ideas. Similarly, Goldie's machine (Patent No. 707,840) for blowing cement could not, so far as appears, have been used as it stood for concrete, and never was so used. The Supreme Court case does not require us to reconsider the validity of McMichael's patent.

In the suit against Storrie & Co., Judge Bourquin seems to have relied to some extent, at least, upon patents which were not in the record in the Ulen case and are not now before us. But whatever the court as now constituted might think of the correctness of our former ruling, it is our duty to follow it unless new evidence raises questions of the patent's validity not previously considered. See *Cortelyou* v. *Charles E. Johnson & Co.*, 145 F. 933, 934 (C. C. A. 2); *Crier* v. *Innes*, 170 F. 324 (C. C. A. 2).

The new evidence of the patent art upon which appellants rely to distinguish the Ulen decision includes two patents granted in 1872 to W. H. Smith, No. 122,497, is for an improvement in concrete pavements and claims concrete "prepared for use in a liquid or semi-liquid condition, capable of flowing in pipes and running into molds." No. 122,498 discloses a machine for mixing liquid concrete and conveying it by a discharge pipe from the mixer to the spot where it is to be laid. The concrete is to flow through the discharge pipe by gravity or, as an alternative, after flowing by gravity through a small winding passage into a chamber, F, is to be forced into the discharge pipe by the pressure of steam or compressed air admitted into the chamber above the mass of the concrete. The chamber has a flat bottom of large area relative to the size of the discharge pipe, the outlet of which opens into the center of the bottom. While this machine discloses the idea of forcing concrete through a pipe by compressed air, whether it was practically operable may be well doubted. It would seem that a large quantity of the concrete, or at least of the stones of which it is partly composed, would necessarily accumulate upon the flat bottom of the chamber. In any event, it was very different from McMichael's device which injects air into the concrete at its entrance into the discharge outlet. It cannot be regarded as an anticipation. Nor can the argument that the patent in suit is limited to "dry" concrete as distinguished from defendants' "wet" concrete prevail. It declares on page 3, line 55,

> "It is equally well adapted for the treating and handling of a mass containing a considerable excess of water in case such an excess is for any reason found desirable."

The other new references in the Patent Office (Canniff, McIlvrid, Beach and Davidson) we regard as less per-

suasive than those which were passed upon in the Ulen case.

The new defense of prior use was held by the district court not sufficiently proved; and with this we agree. This use was of a machine which Artingstall and Fanning said that they saw laying a concrete floor in 1903, subsequently changing the date to 1904. That was twenty-two years before they gave their testimony, and there was no documentary corroboration of any kind. It is true that in 1918 Artingstall described very generally before a meeting of engineers that this process was practiced in 1903, but that cannot be deemed documentary corroboration. Fanning says the machine was also used in one section of a tunnel in Chicago in 1903 and was apparently abandoned as too expensive. It is one thing to say that a continuous use to date may be found on oral testimony to have started at a given time, and quite another to say that such testimony is enough when it describes only a casual use, abandoned thereafter, and never entering into the art until after the patent in suit was applied for, an interval of nearly three years. Such casual and abandoned uses do not contribute to the stock of knowledge which makes up the art. If we may invalidate a patent upon such prior uses so proved, no patent would be safe. A prior use such as constitutes an anticipation was not proven with the degree of certainty which the courts require. See *Deering* v. *Winona Harvester Works*, 155 U. S. 186, 300; *Internat. Cork Co.* v. *New Process Cork Co.*, 6 F. (2d) 420, 424 (C. C. A. 2); *De Laski & Thropp Co.* v. *Fisk Rubber Co.*, 203 F. 986 (C. C. A. 1).

Much argument has been expended in an effort to establish just how the plaintiff's and defendants' machines operate in sending the concrete through the discharge pipe—the plaintiff contending that both discharge it in a succession of slugs or pistons, while the defendants claim

that both, or at least theirs, operate kinetically and float the materials in the air, just as sand or grain is carried in flotation. To us the dispute seems irrelevant. The patent says nothing which commits the patentee to the slug method of operation. The theory is built upon the use of the phrase "submasses," as in lines 72 and 89, page 2, where it is said that the lower air jet "engages with the submasses to push them along." But this cannot mean solid "slugs" for on the same page, lines 92-99, the effect is said to be thoroughly to commingle all the ingredients and insure a better mix. Again, at line 113, page 3: "The delivery pipe itself becomes a mixing chamber wherein pneumatic mixing is effected or continued"; and see also, line 86, page 3. Such statements necessarily forbid the notion of solid slugs. All that is meant by "submasses" is the portions that descend into the discharge pipe, 14, and by their descent are separated from the general mass in the main chamber, 1. It is a synonym for "portions of the mass as they move toward and into the discharge duct," line 53, page 2. Moreover, several of the claims in suit are for the apparatus or machine, and if they are infringed it is enough for the purposes of this suit whether the machine discharges its concrete kinetically or in successive slugs. Neither theory is entirely persuasive. Artingstall's opinion that the inner portion would be blown ahead of that at the circumference of the pipe which would be retarded by friction, seems sensible. On the other hand, it is difficult to believe that particles of the mixture, including stones of an inch and half in diameter, are floated independently in the air, as sand or grain is blown. Ray's testimony regarding the stones effectively disposes of that possibility under any such pressures as are used. It would seem to us that the mass as a whole must block the passage of air, forming an obstruction which yields at different

points because of its uneven power of resistance, and that the heavier stones must be carried by the impact and momentum and cohesion of the lighter substances, the whole mass going forward in a constantly agitated mixed stream, just as McMichael describes. But whether the concrete goes forward as we imagine or in some other manner, there is no sufficient reason to suppose that defendants' machine does not operate in the same manner as plaintiff's whatever that manner may be. The district court on conflicting evidence found infringement of the method claims (4 and 6) as well as of the apparatus claims. We are not convinced that this finding was wrong.

Apparently the "slug" theory was brought into the argument because it was thought necessary to distinguish in this way from Farnham, Warren and Goldie. We have already suggested that those machines would require modifications to operate with concrete containing stones, an inch and a half in diameter. Whether this was the ground adopted to distinguish them in the Ulen case, or whether the court as then constituted accepted the slug theory, does not appear and is not important. On some ground we distinguished the prior art and sustained the validity of the patent, and that ruling we should follow until its error is pointed out by higher authority.

It is urged that the defendants' structure and operation are different in that (1) they do not use "dry," air-impervious concrete, (2) they do not put compressed air pressure behind the concrete mass, (3) they do not use a second compressed air stream at the bottom of the chamber to break the dry concrete into slugs, and (4) they do not push the concrete through the delivery pipe in "slugs" by air pressure from behind.

We have already alluded to a portion of the specifications which indicates that the patent is not limited to "dry" concrete. It is true that the defendants' machine

in its present form, whether or not this was so when the suit was started, is operated without an air-inlet into the discharge chamber above the mass of concrete. But it is admitted by defendants' witnesses that as soon as air is injected into the discharge pipe, it is forced through the concrete and establishes a pressure in the chamber above. Mr. Ray, plaintiff's expert, testified that because of this the operation without the top air inlet is identically the same for all practical purposes as with the top inlet. While the claims which specify an upper air inlet (*e. g.*, claims 2, 17, 34 and 35) might not be infringed by a machine which omits it, the other claims in suit make no reference to the upper air inlet. We think there is clearly infringement of claims 4, 6, 21, 22 and 28. The final decree appealed from awards money damages and is sustainable on the infringement of these claims, even though other claims in suit were not infringed by the machine used by defendants at the time of the trial. The decree is accordingly affirmed. Manton, J., dissents.

A true copy,
WM. PARKIN,
Clerk.